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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,852	01/15/2002	Daniel A. Hilbrich	29929/38327	5104

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EXAMINER

ALEXANDER, REGINALD

ART UNIT	PAPER NUMBER
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1761

MAIL DATE	DELIVERY MODE
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08/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/047,852

Applicant(s)

HILBRICH, DANIEL A.

Examiner

Reginald L. Alexander

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1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed, after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-12, 14-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 14-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Reissue Applications

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

Applicant has used the language "I acknowledge the duty to disclose information of which I am aware and which is material to examination of this reissue application" rather than the required "material to patentability".

Claims 1-8, 10-12, 14-21 and 23-28 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath is set forth in the discussion above in this Office action.

Additionally, on page 1, item 3 of the same reissue oath, it is confusing because this sentence is incomplete. It ends "the Second". Please provide clarification of this paragraph.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 10-12, 14-21 and 23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for a "metallic" filter or "elevated" pressure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7, 8, 10, 12, 14, 16-18, 21, 23, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al.

There is disclosed in Smith a filtering device 10, comprising: a spout 24 to deliver heated water under elevated pressure (col. 3, lines 52-56) to coffee beans; a receptacle (col. 2, lines 22-27) to receive brewed filtered coffee; means 37, 38 defining a flow path between the beans to the receptacle; a metallic (permanent) filter 44 in the path of heated coffee; and a filter layer 42, the filter optionally being of filter paper (col. 4, lines 51 and 52) in the path of the heated coffee. The filtering device is disclosed for use with various types of coffee makers, i.e. espresso coffee makers.

It should be noted that while Smith discloses element 44 as a "foraminous support", such functions as a filtering element. Thus, contrary to the view point presented in the Affidavit submitted July 9, 1999, there are two different filtering elements disclosed in Smith. The permanent or metallic filter 44 provides support for an additional filtering element 42 which, as discussed above, can be a layer of filter paper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 6, 19, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Krebs.

Krebs discloses that it is known in the art to form a filter 10 of multiple layers 12, 14. It would have been obvious to one skilled in the art to modify the construction of the Smith filter 42 with that taught by Krebs and form it of multiple layers, in order to improve the efficiency of the filter. The formation of multiple layers together by crimping is an obvious matter of design choice, since the overall effectiveness of the filter is not contingent upon the way the layers are formed together.

Claims 5, 11, 15, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al.

Smith, as discussed above, discloses all of the claimed subject matter except the desired lipid removal value. Applicant has failed to disclose any particular chemical makeup of the filter paper which would allow it to have the absorbency characteristics described in the claims. It is known in the art that the presence of fats (lipids) from the coffee grounds can make for an undesirable taste in the final coffee product. Thus, the use of filter paper for the removal of fats to improve the taste of coffee. An increase in

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the amount of fats removed from the coffee grounds, and therefore a better taste, can be clearly linked to the thickness or number of filter paper layers used in the filter. In regards to the claims, it would have been obvious to one skilled in the art to achieve, with the Smith reference, the desired fats removal from the coffee grounds, for the reasons set forth in the comments above and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Response to Arguments

Applicant's arguments filed 17 July 2006 have been fully considered but they are not persuasive. Applicant has traversed the rejection under 35 U.S.C. 102 on the grounds that the support sheet of Smith is incapable of filtering fine espresso coffee grounds. It is the opinion of the examiner that where apparatus claims are involved, the prior art reference to Smith discloses all of the claimed structural limitations of the claims. It is known in the art that the trapping of lipids is the purpose of filter paper and it is the opinion of the examiner that the filter paper disclosed in Smith is of such a size to perform the desired function. Applicant argues that there is no motivation provided to combine the references of Smith and Krebs. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art.

References are evaluated by what they suggest to one versed in the art, rather than by

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their specific disclosures. In this case the Krebs references suggest the use of multiple layers of filter paper to improve the filtration process. Thus, increasing the amount of lipids removed and improving the taste of the beverage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reginald L. Alexander whose telephone number is 571-272-1395. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rla
30 April 2007


Reginald L. Alexander
Primary Examiner
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